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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,390	11/12/2003	Charles E. Taylor	SHPR-01041USX	6836
23910	7590	05/12/2005	EXAMINER	
FLIESLER MEYER, LLP FOUR EMBARCADERO CENTER SUITE 400 SAN FRANCISCO, CA 94111			VERSTEEG, STEVEN H	
		ART UNIT	PAPER NUMBER	
		1753		

DATE MAILED: 05/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/706,390	TAYLOR ET AL.	
	Examiner Steven H. VerSteeg	Art Unit 1753	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 April 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2,4-9 and 11-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,2,4-9 and 11-18 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 12 November 2003 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/11/05</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 2, 4-9 and 11-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation regarding the user to not touch any portion of the air conditioner system other than the handle that is found in claims 1, 6, 9, 16, 17, and 18 is considered to be new matter. The limitation added to claims 4 and 11 is also considered to be new matter. Claims 2, 4, 5, 7, 8, and 12-15 depend from claims containing new matter and contain all of the limitations of the claims from which they depend. Thus, claims 2, 4, 5, 7, 8, and 12-15 are rejected for the same reasons as the claims from which they depend.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 8 recites the limitation "the resting position" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

6. Claim 11 depends from canceled claim 10 and is thus indefinite.

***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 9 and 14-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 11, and 19 of copending Application No. 11/041,926. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are fully disclosed in the claims of the pending reissue application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. For claim 9 of the instant invention, Applicant requires an air conditioner system comprising a housing having at least one vent and an opening in a top surface of the housing; an ion generating unit positioned in the housing including an emitter electrode array, collector electrode array, and a high voltage generator to provide a potential difference between the emitter electrode array and the collector electrode array; and a user-liftable handle connected to the collector electrode array; wherein the handle is accessible to a user from outside the housing

without requiring the user to touch any portion of the air conditioner system other than the handle; and wherein the collector electrode array is removable from the hosing using the handle through the opening in the top surface of the housing and is returnable to the housing through the opening in the top surface of the housing.

10. Claim 6 of the reissue application claims all of the limitations of claim 9 of the patent except for the high voltage generator to provide a potential difference between the arrays and the handle being such that the user does not touch any portion of the air conditioner other than the handle. Claim 1 of the reissue application discloses the use of a high voltage generator that provides a potential difference between two electrodes in an air conditioner system.

11. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of claim 6 to utilize a high voltage generator as taught in claim 1 because of the desire to provide power to the air conditioner system.

12. Claim 19 of the reissue application claims the handle in an ion producing system that isolates the user from the ion-generating unit.

13. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of claim 6 to utilize the handle configuration taught by claim 19 because of the desire to isolate the user from the electrodes.

14. For claim 14, Applicant requires the housing to be vertically elongated. Claim 6 of the reissue application does not disclose the direction of the elongation, but claim 11 of the reissue application discloses the housing for a similar system to be vertically elongated.

15. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of claim 6 of the reissue application to have the elongation

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vertically as taught by claim 11 of the reissue application because of the desire to utilize an alternately claimed embodiment.

16. For claim 15, Applicant requires the collector electrode array to include at least one vertically elongated collector electrode. Because claim 6 of the reissue application already claims the collector electrode to be elongated along the direction of the housing and the hosing being vertically elongated is obvious as noted above, the limitation is met.

17. For claim 16, Applicant requires an air conditioning system comprising an upstanding, vertically elongated housing having a vertical channel with an opening in a top surface of the housing and at least one air vent allowing air to enter the vertical channel; an ion generating unit positioned in the housing including an electrode assembly to rest within the vertical channel; and a handle secured to at least a portion of the electrode assembly to assist a user with lifting the assembly vertically out of the channel wherein the handle is accessible to a user from outside the housing without requiring the user to touch any portion of the air conditioner system other than the handle; and wherein the collector electrode array is removable from the hosing using the handle through the opening in the top surface of the housing and is returnable to the housing through the opening in the top surface of the housing.

18. Claim 6 of the patent discloses an air conditioner system containing all of the limitations of claim 16 except for the housing being vertically elongated and the handle being such that the user does not touch any portion of the air conditioner other than the handle, but claim 11 of the patent discloses the housing for a similar system is vertically elongated.

19. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of claim 6 of the patent to have the elongation vertically as

taught by claim 11 of the patent because of the desire to utilize an alternately claimed embodiment.

20. Claim 19 of the reissue application claims the handle in an ion producing system that isolates the user from the ion-generating unit.

21. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of claim 6 to utilize the handle configuration taught by claim 19 because of the desire to isolate the user from the electrodes.

22. For claim 17, Applicant requires an air conditioning system comprising an upstanding, vertically elongated housing having at least one air vent and an opening in a top surface of the housing; an ion generating unit positioned in the housing including at least one emitter electrode, at least one collector electrode elongated along a direction of elongation of the housing wherein the handle is accessible to a user from outside the housing without requiring the user to touch any portion of the air conditioner system other than the handle; and wherein the collector electrode array is removable from the housing using the handle through the opening in the top surface of the housing and is returnable to the housing through the opening in the top surface of the housing.

23. Claim 6 of the patent discloses an air conditioner system containing all of the limitations of claim 17 except for the housing being vertically elongated and the handle being such that the user does not touch any portion of the air conditioner other than the handle, but claim 11 of the patent discloses the housing for a similar system is vertically elongated.

24. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of claim 6 of the patent to have the elongation vertically as

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taught by claim 11 of the patent because of the desire to utilize an alternately claimed embodiment.

25. Claim 19 of the reissue application claims the handle in an ion producing system that isolates the user from the ion-generating unit.

26. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of claim 6 to utilize the handle configuration taught by claim 19 because of the desire to isolate the user from the electrodes.

***Response to Amendment***

27. The double patenting rejection of claim 9-11 and 14-17 over Us 6,713,026 B2 presented in the office action mailed February 22, 2005 is withdrawn in light of the amendment.

28. The provisional double patenting rejection of claim 16 over claims 4 and 8 of US Application No. 10/074,379 presented in the office action mailed February 22, 2005 is withdrawn in light of the amendment.

29. The provisional double patenting rejection of claim 16 over claims 57 and 85 of US Application No. 10/023,460 presented in the office action mailed February 22, 2005 is withdrawn in light of the amendment.

30. The provisional double patenting rejection of claim 16 over claim 34 of US Application No. 10/023,197 presented in the office action mailed February 22, 2005 is withdrawn in light of the amendment.

31. The provisional double patenting rejection of claims 9-11 and 14-17 over claims 9-11, 14, and 15 of US Application No. 10/815,230 presented in the office action mailed February 22, 2005 is withdrawn in light of the amendment.

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32. Please note that the rejections were withdrawn in light of the amendment that the handle makes it so the user doesn't touch any portion of the air conditioner system other than the handle, which is considered to be new matter. Should the new subject matter be deleted, it is likely that double patenting rejections would again be necessary regarding the above application and potentially 10/419,437 and 10/062,057.

#### *General Information*

For general status inquiries on applications not having received a first action on the merits, please contact the Technology Center 1700 receptionist at (571) 272-1700.

For inquiries involving Recovery of lost papers & cases, sending out missing papers, resetting shortened statutory periods, or for restarting the shortened statutory period for response, please contact Denis Boyd at (571) 272-0992.

For general inquiries such as fees, hours of operation, and employee location, please contact the Technology Center 1700 receptionist at (571) 272-1300.

#### *Conclusion*

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

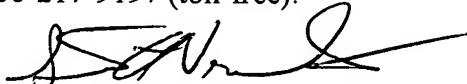
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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven H. VerSteeg whose telephone number is (571) 272-1348. The examiner can normally be reached on Mon - Thurs (6:30 AM - 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X. Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven H VerSteeg  
Primary Examiner  
Art Unit 1753

shv  
May 10, 2005